

cutting of the tape of Example d (page 10) from a "crush cutting knif " to a --rotary cutting knife--. Support for this amendment is found at page 6, lines 27-30. The brief description of the drawings inserted at page 19 finds support at page 10, lines 17-19. No new matter is added.

Claim 1 has been amended to more specifically recite that the cleavage strength of the composite backing is less than the bond strength of the adhesive. Support can be found at page 3, lines 15-17 and page 6, lines 8-11.

Claims 1-13 stand rejected under 35 U.S.C. 112, second paragraph, for use of the phrase "low release force" in claim 1. Claim 1 has now been amended to cancel that phrase, and the rejection of claims 1-13 under 35 U.S.C. 112, second paragraph, should be withdrawn.

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as obvious over Crass et al (U.S. 4,673,611) in view of either Freedman (U.S. 5,876,816) or EP 0 404 402.

The Examiner reads Crass as disclosing a co-extruded, biaxially oriented multilayer polypropylene film coated with an adhesive composition. Although the Examiner acknowledges that Crass lacks a teaching related to delamination of the layers of the backing, he reads the secondary references as teaching tamper indicating tapes in which the backing layers adhere to each other until they separate under a suitable force. From this the Examiner concludes that those skilled in the art would tak the film of the

primary reference and treat it in the manner disclosed by each of the secondary references.

If the Examiner will take a closer look at Crass however, he will see that at col. 2, lines 24-32, Crass requires that an "anti-adhesive substance", such as silicone, (i.e., a release material) be mixed into the composition of Crasses "second" layer. Crasses "first" layer, on the other hand, is three-times as thick as his "first" layer, and is of improved strength (col. 1, line 64 - col. 2, line 12).

If one reads EP 0 404 402 for the whole of what it discloses, one will see that the backing of the EP'402 reference is a single layer composed of two different copolymers, which are incompatible with each other, so that the single layer has a low cohesion (i.e., has a low strength). This reference cannot possibly be combined with Crass, since Crass needs his second layer as an essential part of his invention. Moreover, Crass takes pains to make his main layer (i.e., "thick" layer 1) a high-strength layer, and adds special resins to it to provide the desired strength.

Crass and EP '402 are therefore *incompatible* with each other, and cannot be combined. Even if they were combined, Applicants' adhesive tape could not possibly be arrived at.

Freedman, on the other hand, is directed to a label, not a tape. As discussed in Applicants' specification, at pag 2, lines 14-22 and at page 7, line 34 - page 8, line 6,

such labels have certain disadvantages which are overcome by the adhesive tape of the present invention.

Moreover, there is absolutely nothing in Freedman that could be imported into Crass; the two relate to entirely different things.

Nothing in Freedman teaches or suggests anything about a tape.

No combination of Crass with either EP "402 or Freedman could therefore lead to Applicants' novel adhesive tape, and the rejection of claims 1-13 under 35 U.S.C. 103(a) as obvious over Crass et al (U.S. 4,673,611) in view of either Freedman (U.S. 5,876,816) or EP 0 404 402 should now be withdrawn.

It is also emphasized once again, that Crass teaches away from the present invention. Crass uses a two layer support film to provide an adhesive tape which can be easily drawn off from a roll without delamination! Crass, at col. 1, lines 11-18, cites DE 32 16 603. This reference describes another tape that is designed in such a manner that delamination is avoided when the tape is drawn off from a roll, and Crass seeks to improve on this and provide a tape that will never delaminate. Thus, no one seeking a tape that would delaminate would ever consider Crass. Stated differently, no person reading Crass would be interested in either of the secondary references, because their teachings are in the opposite direction of Crass.

The mere fact that the prior art could be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d. 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Nothing in the references cited would teach or suggest a desire to modify the invention of Crass to do exactly the opposite of what it is intended by Crass to do. Accordingly, there is no motivation to combine Crass with the secondary references cited.

In view of the present amendment and remarks it is believed that claims 1-13 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No.

14-1263.

Respectfully submitted,  
NORRIS, McLAUGHLIN & MARCUS

By William C. Gerstenzang

William C. Gerstenzang  
Reg. No. 27,552

WCG:tmh  
220 East 42<sup>nd</sup> Street - 30<sup>th</sup> Floor  
New York, New York 10017  
(212) 808-0700

I hereby certify that this correspondence is being transmitted via facsimile addressed to Hon. Assistant Commissioner For Patents, Washington, D.C. 20231 on November 26, 2002

William C. Gerstenzang

Date: November 26, 2002

**MARKED-UP COPY OF AMENDED PARAGRAPH**  
**SHOWING CHANGES RELATIVE TO PREVIOUS VERSION**

Paragraph beginning at page 10, line 17 (amended).

Figures 1 and 2 show the [crush] rotary cutting knife 1 which was used. The knife 1 has 604 teeth 2. The cutting phase angle  $\alpha$  is  $90^\circ$ . The tooth width A is 0.2 mm, the cut-face width B is less than 0.05 mm.

**MARKED-UP COPIES OF AMENDED CLAIM  
SHOWING CHANGES RELATIVE TO PREVIOUS VERSION**

Claim 1 (amended). An adhesive tape comprising a composite backing based on an oriented, coextruded, at least two-layer polypropylene film whose one side is provided with an adhesive composition [and whose film layers have a low release force with respect to one another] wherein the cleavage strength of the composite backing is less than the bond strength of the adhesive.